

REMARKS

Claims 16 to 29 appear in this application for the Examiner's review and consideration. Claims 17, 19 to 21, and 27 to 29 are withdrawn as being directed to a non-elected species. The claims are fully supported by the specification and claims as originally filed. Therefore, there is no issue of new matter.

Election of a single disclosed species for prosecution on the merits was required under 35 U.S.C. 121. The claims will be restricted to the elected species if no generic claim is finally held to be allowable.

In response, Applicants elect, with traverse, the following:

Species B in which the alloy element contents by weight are Sn=1.2% to 1.7%, Fe=0.18% to 0.24%, Cr=0.05% to 0.1 5%, O=900 ppm to 1600 ppm;

Species F in which the rolling performs a 5% to 16% reduction; and

Species H in which the product is made into a fuel element of a light water reactor.

Claims 16, 24, and 25 are generic. Claims 18, 22, 23, and 26 read on the elected species.

It is respectfully submitted that the species restriction is improper and should be withdrawn for the following reasons. At page 2, the Office Action states:

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

However, as stated in the M.P.E.P., “[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” M.P.E.P. § 1893.03(d). In this regard, the Office Action, at pages 4 and 5, states:

The special technical feature of species A is a composition having Fe=0.07% to 0.20%, while the special technical feature of species B is a composition having Fe=0.18% to 0.24%. Since the special technical feature of species A is not present in claims drawn to species B and the special technical feature of species B is not present in claims drawn to species A, unity of invention is lacking. An analogous argument can be made with regard to the other species as to why unity of invention is lacking.

However, there is a clear overlap between the ranges of Fe in species A and species B. Therefore, the special technical feature of species A, as identified in the Office Action, is present in claims drawn to species B. In fact there is an overlap in the content of at least one alloy element in all of species A, B, C, D, and E. Therefore, the special technical feature of the invention, as identified in the Office Action, is present in all the claims. Similarly, the reduction ratio of species G falls entirely within the scope of species F. Again, the special technical feature of species F, as identified in the Office Action, is present in claims drawn to species G. Applicants respectfully submit that the claims recite a single general inventive concept, such that the claims meet the unity of invention requirement. Thus, it appears that unity of invention practice has not been properly applied to the present application.

In this regard, Applicants respectfully submit that the special technical feature of the invention is clearly set forth in claim 16. As disclosed in the present the specification, the invention provides a particular type of microstructure that is obtained with the thermo-mechanical treatment conditions recited in the claims. The method of the invention can be used with any kind of Zr alloy useful in the nuclear industry. The specific alloys recited in the claims are examples of usual classes of alloys, as set forth in the introduction of the specification. Thus, the process of claim 16 can be used with all Zr alloys with less than 5 percent alloying elements. Such a concentration of allowing materials is typically for most commercial Zr alloys in the nuclear industry.

Moreover, Applicants respectfully submit that the examination of Groups A to H together would not impose a serious burden on the Examiner. One of ordinary skill in the art will understand that the process recited in independent claim 16 is clearly useful for all Zr alloys having less than 5 percent of alloying elements. Thus, a search of any of the species set forth in the Office Action will provide the same results as a search of any other species. Therefore, searching all of the species set forth in the Office Action places not additional burden on the Examiner.

Therefore, Applicants respectfully submit that restriction practice has been has improperly applied to the present application, and the outstanding Restriction Requirement has been overcome. Accordingly, it is respectfully requested that the Examiner withdraw the Restriction Requirement, and rejoin the withdrawn claims.

Applicants thus submit that the entire application is in condition for allowance, an early notice of which would be appreciated. Should the Examiner not agree with Applicants' position, a personal or telephonic interview is respectfully requested to discuss any remaining

issues prior to the issuance of a further Office Action, and to expedite the allowance of the application.

No fee is believed to be due for the filing of this Amendment. Should any fees be due, however, please charge such fees to Deposit Account No. 11-0600.

Respectfully submitted,

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